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09/176,012	10/20/98	METTERNICH	GE997-053

IBM CORPORATION 972/B656
INTELLECTUAL PROPERTY LAW
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EXAMINER

DAVIS, T

ART UNIT

PAPER NUMBER

2681

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/176,012

Applicant(s)

Metternich et al.

Examiner

Temica M. Davis

Group Art Unit

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☒ Responsive to communication(s) filed on Oct 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-29 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-29 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Objections

1. Claims 4-15, 18, 19, 21, 22 and 27-29 are objected to because of the following informalities: In claims 4, 5 and 7-14, 18, 19, 22, 27-29, line 1, "Claims" should read --Claim-- In claims 6 and 7, line 1, "the data link" should read --a data link--, line 2, "the data processing system" should read --a data processing system--. In claim 8, line 2, "the server" should read --a server--, line 3, "the data processing system" should read --a data processing system-- and "the user" should read --a user--. In claim 9, line 2, "the SMS" should read --a SMS--. In claim 13, lines 2-3, "the mobile radio network" should read --a mobile radio network--, line 3, "the user" should read --a user--. In claim 15, line 3, "the data-processing system of the user" should read --a data-processing system of a user--. In claim 19, line 2, "the telephone number" should read --a telephone number--, line 3, "the entitlement" should read --an entitlement--. In claim 21, line 1, "the data link" should read --a data link--. In claim 22, line 2, "the server" should read --a server--. In claim 23, lines 2-3, "the mobile radio network operator" should read --a mobile radio network operator--, "the telephone network" should read --a telephone network--, and "the user" should read --a user--. Appropriate correction is required.

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1, 2, 6, 10, 12, 15, 16, 20, 23, 25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Honda, U.S. Patent No. 5,875,405.

Regarding claim 1, Honda discloses:

a) preparing A query profile, having at least one information requirement and an associated brief command, where the brief command can be specified using the keypad of a mobile telephone (col. 3, line 61-col. 4, line 30);

b) sending the query profile to an information supplier (col. 4, lines 27-30);

c) sending on information call using a mobile telephone to the information supplier containing at least the brief command (col. 5, lines 15-25);

d) inherently comparing the brief command in accordance with step c) with the brief command of the information requirement of the query profile in accordance with step b) as evidenced by the fact that an acknowledgment from the base station was received at the mobile and the base station transfers the requested information to the mobile (col. 5, lines 19-30);

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e) putting together the Information of the specified information requirement in the event of agreement In accordance with step d) (col. 5, lines 40-49);

f) sending the collected Information to the mobile telephone (col. 5, lines 50-58); and

g) reproducing the information by way of the mobile telephone (col. 5, lines 50-58).

Regarding claim 2, Honda discloses the method in accordance with Claim 1 characterized in that step a) takes place via a data-processing system (col. 3, lines 54-56) and step b) via a data link (RF) between the data processing system of a user of the mobile telephone and the data processing system of the information supplier (figure 1).

Regarding claim 6, Honda discloses the method in accordance with Claim 1 characterized in that the data link is effected through a modem to the data-processing system of the information supplier (figure 1).

Regarding claim 10, Honda discloses the method in accordance with Claim 1 characterized in that steps d) through f) are inherently each effected through one of the information suppliers programs as evidenced by the fact the actions are taking place within the information supplier (base station) (col. 5, lines 19-55).

Regarding claim 12, Honda discloses the method in accordance with Claim 1 characterized in that sending, in accordance with step f), is effected via a mobile telephone (col. 5, lines 50-58).

Regarding claim 15, Honda discloses::

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a) preparing a query profile, having an associated brief command at least one information requirement specified, where the brief command can be produced using the keypad of a mobile telephone (col. 3, lines 54-56, col. 4, lines 12-30);

b) sending the query profile in accordance with step a) to an information supplier (col. 4, lines 27-30); and

c) storing the query profile at the information provider on a data-processing system which can communicate with the telephone network of the mobile telephone (col. 4, lines 2-8; figure 1).

Regarding claim 16, Honda discloses the method in accordance with Claim 15 characterized in that step a) is effected via a data-processing system (col. 3, lines 54-56) and that step b) is effected over a data link (RF) between the data-processing system of a user of the mobile telephone and the data-processing system of the information provider (figure 1).

Regarding claim 20, Honda discloses the method in accordance with Claim 15 characterized in that the data link is effected through a modem to the data processing system of the information provider (figure 1).

Regarding claim 23, Honda discloses:

a) sending a call for information by means of the mobile telephone to the information provider containing at least the brief command (col. 3, line 61-col. 4, line 30);

b) inherently comparing the sent brief command with the brief command of the information requirement of the query profile as evidenced by the fact that an acknowledgment

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from the base station was received at the mobile and the base station transfers the requested information to the mobile (col. 5, lines 19-30);

c) putting together the desired information of the information requirement in the event of agreement in accordance with step b) (col. 5, lines 40-49);

d) presenting the collected information to the mobile telephone (col. 5, lines 50-58); and

e) reproducing the information via the mobile telephone (col. 5, lines 50-58).

Regarding claim 25, Honda discloses the method in accordance with Claim 23 characterized in that steps b) through d) are inherently effected through a program of the information provider as evidenced by the fact the actions are taking place within the information supplier (base station) (col. 5, lines 19-55).

Regarding claim 27, Honda discloses the method in accordance with Claim 23 characterized in that the transmission in accordance with step d) is effected via a mobile telephone (col. 5, lines 50-58).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 3, 4, 5, 13, 17-19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda, U.S. Patent No. 5,875,405 and well known prior art.

Regarding claims 3 and 17, Honda discloses the method in accordance with Claims 1 and 15 as described above. Honda, however, fails to specifically disclose wherein the query profile is produced by a speech computer.

The examiner, however, contends that it is very well known in the art that information can be produced by means of a speech computer.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Honda with the teachings of well known prior art for the purpose of having the capability to provide information during times when a user of the mobile phone can't use their hands to submit information.

Regarding claims 4 and 18, Honda discloses the method in accordance with Claims 1 and 15 as described above. Honda, however, fails to specifically disclose wherein the information call is sent with a PIN, where the PIN establishes entitlement to call up the specified information.

However, the examiner takes official notice that it is well known in the art for a PIN to be transmitted along with requested information from a user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Honda with the teachings of well known prior art for the purpose of verifying the user requesting the information for security purposes.

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Regarding claims 5 and 19, Honda discloses the method in accordance with Claims 1 and 15 as described above. Honda, however, fails to specifically disclose wherein the information

call is sent with the telephone number of the caller, where the telephone number establishes entitlement to call for the information.

However, the examiner takes official notice that it is well known in the art for the telephone number to be transmitted along with requested information from a user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Honda with the teachings of well known prior art for the purpose of verifying the user requesting the information for security purposes.

Regarding claims 13 and 28, Honda discloses the method in accordance with Claims 1 and 23 as described above and further discloses information being transferred on a data link between the mobile and the information provider. Honda, however, fails to specifically disclose wherein the information is sent to a user of the mobile telephone via a network operator.

The examiner however, takes official notice that it is well known in the art to incorporate network operators as suppliers of information to a mobile user.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Honda with the teachings of well known prior art as it would have been a design preference based on the desired system performance.

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6. Claims 7, 9, 14, 21, 24, and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Honda, U.S. Patent No. 5,875,405 and Sormunen et al (Sormunen), U.S. Patent No. 6,112,078.

Regarding claims 7 and 21, Honda discloses the method in accordance with Claims 1 and 15 as described above. Honda, however, fails to specifically disclose wherein a data link is affected through the Internet to a data processing system of the information supplier.

Sormunen discloses wherein a data link is affected through the Internet to a data processing system of an information supplier (col. 4, lines 4-11).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Honda with the teachings of Sormunen for the purpose of having the ability to access user services "on-line" (Sormunen, col. 2, lines 32-49).

Regarding claims 9 and 24, Honda discloses the method in accordance with Claims 1 and 23 as described above. Honda, however, fails to specifically disclose wherein step c) and step a) are effected through the SMS of the mobile telephone.

Sormunen discloses a method of sending an information call by means of SMS (col. 3, lines 54-62).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Honda with the teachings of Sormunen for the purpose of making the transfer of information between the systems more secure in that it is more difficult for outsiders to interpret the content of the information being sent (Sormunen, col. 3, lines 33-39 and lines 65-67).

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Regarding claims 14 and 29, Honda discloses the method in accordance with Claims 1 and 23 as described above. Honda, however, fails to specifically disclose wherein the information, in accordance with steps g) and e), are supplied visually or acoustically via the mobile telephone.

Sormunen discloses a method in which requested information is displayed (visual) to the mobile telephone (col. 4, lines 33-39).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Honda with the teachings of Sormunen for the purpose of allowing the user to see the requested information.

7. Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda, U.S. Patent No. 5,875,405, Sormunen et al (Sormunen), U.S. Patent No. 6,112,078 and well known prior art.

Regarding claims 8 and 22, Honda discloses the method in accordance with Claims 1 and 15 as described above. Honda, however, fails to specifically disclose downloading JAVA applets stored on the server of the information supplier through the Internet to the data processing system of the user of the mobile telephone; and preparing the query profile in accordance with step a) by means of the JAVA applets.

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Sormunen discloses a method of downloading information from an information supplier to the data processing system of a user of the mobile telephone by way of the Internet (col. 2, lines 32-49, col. 4, lines 4-11).

The combination of Honda and Sormunen fails to disclose JAVA as the programming language used for the Internet communication. However, it is well known in the art that JAVA is a widely used programming language for the Internet.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Honda and Sormunen with the teachings of well known prior art as it would have been a design preference in choosing the programming language used for the Internet communication based on system and need performance.

8. Claims 11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda, U.S. Patent No. 5,875,405.

Regarding claims 11 and 26, Honda discloses the method of claims 1 and 23 as described above, and inherently a program effected through the information supplier as evidenced by the fact the actions are taking place within the information supplier (base station) (col. 5, lines 19-55). Honda, however, fails to specifically disclose how many programs are being utilized for the steps d), e), f), b), c) and d).

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However, the examiner contends that the number of programs used for implementing the transfer of information is a design preference, and that it would have been obvious to use more than one program based on the desired outcome of the system performance.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Molne, U.S. Patent No. 5,943,611, discloses cellular radiotelephones including means for generating a search request data signal and receiving a telephone number from a network directory database and related methods.

Sicher et al, U.S. Patent No. 6,112,084, discloses cellular simultaneous voice and data including digital simultaneous voice and data (DSVD) interwork.

Landgren, U.S. Patent No. 6,115,754, discloses a system and method for appending location information to a communication sent from a mobile terminal operating in a wireless communication system to an Internet server.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 202314

or faxed to:

(703) 308-6306 or (703) 308-6296 (for any communications intended for entry).

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Temica M. Davis

October 6, 2000



DWAYNE D. BOST
SUPERVISORY PATENT EXAMINER
GROUP 2700